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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,866	12/06/2001	Vijay Kumar	P048,29US1	6560
22885 7590 10/02/2008 MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721				
EXAMINER				
WHITE, EVERETT NMN				
ART UNIT		PAPER NUMBER		
1623				
MAIL DATE		DELIVERY MODE		
10/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/007,866

Applicant(s)

KUMAR ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on June 23, 2008, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Shaojia Anna Jiang, Ph.D./

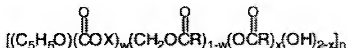
Supervisory Patent Examiner, Art Unit 1623

Claim Rejections - 35 USC § 102

2. Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al (US Patent No. 5,973,139, already of record).

Applicants claim a biodegradable, oxidized cellulose ester having the following general formulas I or II:

I.



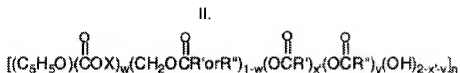
wherein:

X is selected from the group consisting of H, Na, K, Ca, NH₄, and NEt₃H;

whereby R is (CH₂)_n(COOH), where n is 2 to 4;

w is 0.1-1.0; x is 0.1-2.0; and n is 30-1500,

and



wherein:

X is selected from the group consisting of H, Na, K, Ca, NH₄, and NEt₃H;

R' and R'' are each selected from the group consisting of H; CF₃, (CH₂)_nCH₃, where n is from 0 to 18; (CH₂)_nCOOH, where n is from 1 to 8; CY=CZCOOH, where Y and Z are independently selected from the group consisting of hydrogen, methyl, branched alkyl having from 1 to 20 carbon atoms and from one to three *cis* or *trans* double bonds; branched alkenyl having from 1 to 20 carbon atoms and having from one to three *cis* or *trans* double bonds; CY-CH₂, where Y is H, methyl, or phenyl; CH=CHY, where Y is C₆H₅; CH=CYCOOH, where Y is H or CH₃; (CH₂)₆(CH=CH(CH₂)₆CH₃); or C₆H₂₋₆(COOH)₀₋₄, CH₂CH(COOH)CH₂-COOH; w is 0.1-1.0; x' is 0.1-1.9; y is 0.1-1.9; and n is 30-850.

The Lee et al patent discloses various carboxylated cellulose esters that include carboxylated cellulose acetate butyrate, carboxylated cellulose acetate propionate, carboxylated cellulose propionate butyrate and carboxylated cellulose acetate propionate butyrate (see column 4, 4th paragraph), wherein the degree of substitution of each of the acetate, propionate, and butyrate groups along with the degree of substitution of the hydroxyl groups described for each of the recited compounds in column 4, line 47 to column 5, line 9 characterizes the carboxylated cellulose esters to a degree that anticipates the description of the oxidized cellulose esters represented in formula II of instant Claim 36 when the R' and R'' in formula II of instant Claim 36 is represented as (CH₂)_nCH₃, where n is from 0 to 2. The symbols X, w, x', y' and n disclosed in formula II of Claim 36 are also anticipated by the description of the carboxylated cellulose esters of the Lee et al patent.

3. Applicant's arguments filed June 23, 2008 have been fully considered but they are not persuasive. Applicants argue that the biodegradable, cellulose ester of instant

Claim 36 differs from the carboxylated cellulose esters of the prior art because the prior art compounds comprises lactones as part of their structures and the utility of the carboxylated cellulose esters in the prior art such as their use as coatings, indicates that the compounds are not biodegradable. However, this argument is not persuasive since there is no indication in the Lee et al patent that the carboxylated cellulose esters comprise lactone moieties. Also, the use of the compounds as coatings does not mean that the carboxylated cellulose esters, per se, are not biodegradable since the coating compositions of the Lee et al patent comprises other additives that may define the coating composition as non-degradable. Applicants are also reminded that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

Summary

4. Claim 36, the only pending claim, is rejected

Examiner's Telephone Number, Fax Number, and Other Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Everett White/
Examiner, Art Unit 1623

/Shaojia Anna Jiang, Ph.D./
Supervisory Patent Examiner, Art Unit 1623